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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,691	02/14/2007	Philip Wilson Howard	065435-9082-US00	9035
23510 7590 09/29/2008 MICHAEL BEST & FRIEDRICH LLP ONE SOUTH PINCKNEY STREET P O BOX 1806 MADISON, WI 53701				
EXAMINER KIFLE, BRUCK				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
09/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,691

Applicant(s)

HOWARD ET AL.

Examiner

Bruck Kifle

Art Unit

1624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,10 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,10 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date 08/18/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's amendments and remarks filed 06/23/2008 have been received and reviewed. Claims 1, 3-5, 7, 10 and 14-16 are now pending in this application.

Claim Rejections - 35 USC § 112

Claims 1, 3-5, 7, 10 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) The phrase "or pharmaceutically acceptable salts or solvates thereof" should be rewritten as, for example, "or a pharmaceutically acceptable salt thereof" in claim 1, 10, 14 and 16 to comply with proper Markush language. See below for the rejection of "solvates."

ii) The groups R¹⁰ and R¹² are defined as "a nitrogen protecting group" and "an oxygen protecting group," respectively. It is unclear from what these groups are supposed to be protected. The compounds are final products and do not need protection from anything anymore. A clarification is required. Applicants have not responded to this except to say that the specification defines the terms.

iii) Claim 14 is confusing. The claim is drawn to a method of treating a gene-based disease wherein the gene-based disease is infection by gram-positive bacteria. It is unclear how a gene-based disease could be infection by gram-positive bacteria. A gene-based disease is understood to be a condition caused by abnormalities in genes or chromosomes. These are usually called genetic disorders. It is unclear how a bacterial infection falls under a "gene based disease." A clarification is required.

Claims 1, 3-5, 7, 10 and 14-16 are again rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a pharmaceutical salt, does not reasonably provide enablement for solvates of the compound of formula I. The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference. Applicants argue that the disclosure of the compound is more than sufficient to enable solvates. However, the claims, insofar as they embrace solvates are not enabled. All of the examples presented all failed to produce a solvate. The evidence of the specification is thus clear: These compounds do not possess the property of forming solvates; there is no evidence that such compounds even exist. Thus, this is a circumstance where the "specification is evidence of its own inadequacy" (In re Rainer, 377 F.2d 1006, 1012, 153 USPQ 802, 807). These cannot be simply willed into existence. As was stated in Morton International Inc. v. Cardinal Chemical Co., 28 USPQ2d 1190 "The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However ... there is no evidence that such compounds exist... the examples of the '881 patent do not produce the postulated compounds... there is ... no evidence that such compounds even exist." The same circumstance appears to be true here: there is no evidence that solvates of these compounds actually exist; if they did, they would have formed. Hence, applicants must show that solvates can be made, or limit the claims accordingly.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, 10 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thurston et al. (WO 93/18045). The reference teaches a generic group of pyrolobenzodiazepine derivatives which embraces applicants' claimed compounds (See page 3 for structural formula, page 4 for preferred compounds, pages 5-7 for process of making and pages 15-16 for pharmaceutical compositions and methods of use). The claims differ from the reference by reciting specific species and a more limited genus than the reference. The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference.

Applicants argue superior and unexpected results. This, however, needs to be shown in a side by side comparison in declaration form.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is 571-272-0668. The examiner can normally be reached on Mondays-Fridays from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruck Kifle/
Primary Examiner
Art Unit 1624

BK
September 25, 2008